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REPLY UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP

AMENDMENT TRANSMITTAL LETTER				Docket No. 5486-0137PUS1																																																		
Application No. 10/633,578-Conf. #5433		Filing Date August 5, 2003		Examiner M. P. Francis																																																		
Art Unit 2193																																																						
Applicant(s): Bjorn C. RETTIG																																																						
Invention: CROSS LANGUAGE MIGRATION																																																						
<p>MS AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p>Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below.</p> <table border="1"><thead><tr><th colspan="7">CLAIMS AS AMENDED</th></tr><tr><th></th><th>Claims Remaining After Amendment</th><th>Highest Number Previously Paid</th><th>Number Extra Claims Present</th><th colspan="2">Rate</th><th></th></tr></thead><tbody><tr><td>Total Claims</td><td>38</td><td>- 38 =</td><td>0</td><td>x</td><td>50.00</td><td>0.00</td></tr><tr><td>Independent Claims</td><td>3</td><td>- 3 =</td><td>0</td><td>x</td><td>200.00</td><td>0.00</td></tr><tr><td colspan="6">Multiple Dependent Claims (check if applicable) <input type="checkbox"/></td><td></td></tr><tr><td colspan="6">Other fee (please specify):</td><td></td></tr><tr><td colspan="6">TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:</td><td>0.00</td></tr></tbody></table> <p><input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity</p> <p><input checked="" type="checkbox"/> No additional fee is required for this amendment.</p> <p><input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of \$ _____. A duplicate copy of this sheet is enclosed.</p> <p><input type="checkbox"/> A check in the amount of \$ _____ is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge and credit Deposit Account No. <u>02-2448</u> as described below. A duplicate copy of this sheet is enclosed.</p> <p><input checked="" type="checkbox"/> Credit any overpayment.</p> <p><input checked="" type="checkbox"/> Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.</p> <p>_____ Michael K. Mutter Attorney Reg. No.: 29,680</p> <p>BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 Gatehouse Road Suite 100 East P.O. Box 747 Falls Church, Virginia 22040-0747 (703) 205-8000</p> <p>Dated: <u>April 16, 2007</u></p>						CLAIMS AS AMENDED								Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate			Total Claims	38	- 38 =	0	x	50.00	0.00	Independent Claims	3	- 3 =	0	x	200.00	0.00	Multiple Dependent Claims (check if applicable) <input type="checkbox"/>							Other fee (please specify):							TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:						0.00
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Docket No.: 5486-0137PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Bjorn C. RETTIG

Application No.: 10/633,578

Confirmation No.: 5433

Filed: August 5, 2003

Art Unit: 2193

For: CROSS LANGUAGE MIGRATION

Examiner: M. P. Francis

REQUEST FOR WITHDRAWAL OF FINALITY AND
REQUEST FOR RECONSIDERATION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the Office Action dated January 16, 2007, the following remarks are respectfully submitted in connection with the above-identified application as follows:

Remarks/Arguments begin on page 2 of this paper.

REQUEST FOR WITHDRAWAL FINALITY

Prior to addressing the new grounds of rejection set forth in the Office action ("Action"), Applicants respectfully request withdrawal of the finality of the present Action.

In paragraph 8 of the Action, the Examiner asserts that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." However, as stated in §706.07(a) of the MPEP "[a] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed."

In the previous Action, the Examiner asserted that claim 22 included allowable subject matter. Accordingly, in an effort to expedite prosecution, Applicant amended each independent claims (i.e., claims 1, 11, and 24) to include the allowable subject matter of canceled claim 22. Clearly, the Examiner should reasonably expected Applicant to make such an amendment. Therefore, the new grounds of rejection based on the newly cited Guyan reference was not *necessitated* by Applicants amendment. Accordingly, the finality of the present Action is premature. Applicants respectfully request reconsideration and withdrawal of the finality of the present Action.

Applicants note with appreciation the indication in the Interview Summary dated March 20, 2007 that the finality of the present rejection will be withdrawn.

Request for Reconsideration

Claims 1-21 and 23-39 are currently pending, wherein claims 1, 11, and 24 are independent.

In paragraph of 4 of the Action, the Examiner rejects claims 1-4, 8-14, 18-21, 23-27, and 31-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,035,121 to Chiu et al. ("Chiu") in view of U.S. Patent Application Publication No. 2005/0149376 to Guyan et al. ("Guyan"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. §103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivated to combine the cited references. Second, there must be reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-4, 8-14, 18-21, 23-27, and 31-39 are not rendered unpatentable over the combination of Chiu and Guyan because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

Independent claims 1, 11, and 24 are directed to a method, system, and program product for changing a computer system or application from a first language to at least a second language. The method includes, *inter alia*, determining a structure of a system about to be migrated; storing migration information based on the determination of the structure; and performing said migration based on said stored migration information,

wherein performing said migration modifies at least some core code of the computer system from a language dependent form into a language independent form.

In rejecting claims 1, 11, and 24, the Examiner asserts that it would have been obvious to one skilled in the art "to modify or change some core code from a language dependent format to a language independent format to Chiu's invention" in order to "develop component based software capable of handling insurance related tasks." This assertion is unfounded for the following reason.

As discussed in section 2143.01 of the MPEP, the mere fact that references can be combined is not sufficient in and of itself to render the resultant combination obvious absent some evidence of the desirability of the proposed modification. In the present case, the Examiner asserts one skilled in the art would have motivated to modify the method and system for localizing a computer program of Chiu to include alleged teachings of Guyan in order to "develop component based software capable of handling insurance related tasks." However, nowhere in Guyan is there any disclosure or suggestion that changing "some core code from a language dependent format to a language independent format" develops component based software capable of handling insurance related tasks. To the contrary, the modification proposed by the Examiner would merely result in a method for localizing a computer program (i.e., converting the program from a first language to a localized version in a target language) which included user interfaces in different languages. Accordingly, one skilled in the art would *not* have been motivated to modify the system of Chiu as suggested by the Examiner because the proposed modification does not achieve the allegedly desired result.

Furthermore, nowhere in Chiu is there any evidence or suggestion of the desirability of handling insurance-related tasks. To the contrary, the system and method of Chiu are directed to localizing software, not the particular functionality of the software. Clearly, the Examiner's combination of Chiu and Guyan is based on improper hindsight reconstruction. Accordingly, absent proper motivation to combine Chiu and Guyan, the rejection of claims 1-4, 8-14, 18-21, 23-27, and 31-39 is improper.

Furthermore, even if one skilled in the art were motivated to combine the teaching of Chiu and Guyan, which Applicants do not concede, the combination would still fail to render claims 1-4, 8-14, 18-21, 23-27, and 31-39 unpatentable because the combination fails to disclose each and every claimed element. The Examiner acknowledges (see page 3 of the Action), the Chiu fails to disclose modifying at least some core code of the computer system from a language dependent form into a language independent form as claimed. Therefore, the Examiner relies on Guyan to overcome the deficiencies of Chiu. More specifically, the Examiner asserts that Guyan discloses modifying at least some core code of the computer system from a language dependent form into a language independent form in as much as Guyan discloses a flexible user interface wherein multiple language interfaces are accommodated with minimal effort because they utilize the same core code base. To support this assertion, the Examiner points to Fig. 4 element 402 and paragraph 593 of Guyan. These assertions are unfounded.

Nowhere in Guyan is there any disclosure or suggestion of migrating a computer system or application from a first language to a second language. To the contrary,

Guyan solves the problems associated with updates and porting to different languages by providing a single core code base with multiple language interfaces as shown in Fig. 4 and discussed in paragraph 593. However, this is not equivalent to modifying the core code from a first language to a second language as claimed. In fact, Guyan teaches just the opposite. The system of Guyan utilizes multiple language interfaces with the same core code base, resulting in the core code not having to be migrated to each language.

Since Chiu and Guyan both fail to disclose or suggest a method for migrating a computer system or application that includes modifying at least some core code of the computer system from a language dependent form into a language independent form as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Chiu and Guyan, which Applicants do not concede, the combination would still fail to render claims 1, 11, and 24 unpatentable because the combination fails to disclose each and every claimed element.

Claims 2-4, 8-10, 12-14, 18-21, 23, 25-27, and 31-39 variously depend from independent claims 1, 11, and 24. Therefore, claims 2-4, 8-10, 12-14, 18-21, 23, 25-27, and 31-39 are patentable over the combination of Chiu and Guyan for at least those reasons presented above with respect to claims 1, 11, and 24. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-4, 8-14, 18-21, 23-27, and 31-39 under 35 U.S.C. §103(a).

In paragraph 6 of the Action, the Examiner rejects claims 5-7, 15-17, and 28-30 under 35 U.S.C. §103(a) as allegedly being unpatentable over Chiu in view of Guyan, further in view of U.S. Patent No. 5,659,753 to Murphy et al. ("Murphy"). Applicants respectfully traverse this rejection.

Claims 5-7, 15-17, and 28-30 variously depend from independent claims 1, 11, and 24. Therefore, claims 5-7, 15-17, and 28-30 are patentable over the combination of Chiu and Guyan for at least those reasons present above with respect to claims 1, 11, and 24.

Murphy discloses an interface for symbol table construction in a Multilanguage optimizing compiler. However, Murphy fails to overcome the deficiencies of Chiu and Guyan.

Since Chiu, Guyan, and Murphy each fail to disclose or suggest a method for migrating a computer system or application that includes modifying at least some core code of the computer system from a language dependent form into a language independent form as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Chiu, Guyan, and Murphy, which Applicants do not concede, the combination would still fail to render claims 5-7, 15-17, and 28-30 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 5-7, 15-17, and 28-30 under 35 U.S.C. §103(a).

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: April 16, 2007

Respectfully submitted,

By 

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